



07-15-08

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Pat. No.: 6,722,674

Art Unit: 3993

Patentee: Hong-Jiu Gu et al.

Examiner: J. Kaufman

Issued: April 20, 2004

Reexamination No. 95/000,355

Serial No.: 09/909,399

For: Safety Driving Equipment for Scooter

PETITION UNDER 37 C.F.R. § 1.182

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Based on the attached papers, Requester in the above referenced inter partes reexamination proceeding hereby petitions the Commissioner for relief under 37 C.F.R. § 10.18(c). Specifically, Requester requests that Commissioner: (i) terminate the proceedings at their present stage pursuant to 37 C.F.R. § 10.18(c)(6); and (ii) award Requester its costs incurred in bringing the present petition pursuant to 37 C.F.R. § 10.18(c)(2).

The attached submission has been submitted simultaneously to the examiner in the pending proceeding for action by the examiner as appropriate.

Forms PTO/SB/17p and PTO-2038 are submitted herewith for payment of the petition fee. The Commissioner is hereby authorized to charge to deposit account 502903 any additional fees required.

Thank you for your attention to this matter.

A handwritten signature in black ink, appearing to read 'Jeffrey Sonnabend', is positioned above a horizontal line.

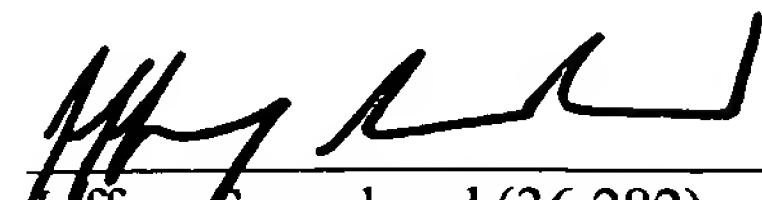
Attorney for Requester  
Jeffrey Sonnabend (36,282)  
SonnabendLaw  
600 Prospect Avenue  
Brooklyn, NY 11215  
JSonnabend@SonnabendLaw.com



### **CERTIFICATE OF SERVICE**

I hereby certify on this day, July 14, 2008, that a true and correct copy of the foregoing  
Petition under 37 C.F.R. § 1.182 was mailed by Express Mail, postage paid, to:

Raymond Y. Chan  
108 N. Ynez Avenue  
Suite 128  
Monterey Park, CA 91754

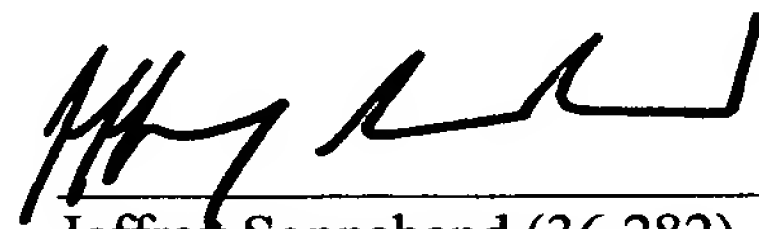
  
Jeffrey Sonnabend (36,282)

Date: July 14, 2008

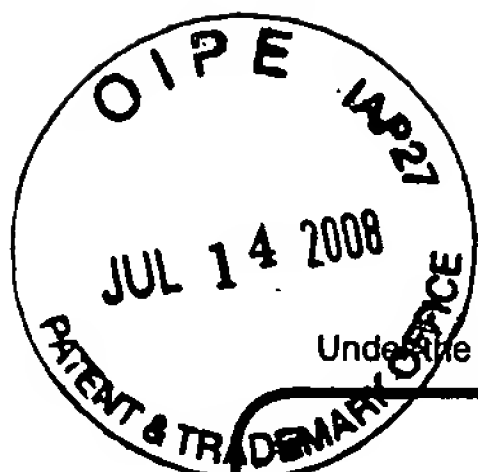
### **CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8**

I hereby certify that the foregoing correspondence is being deposited with the United  
States Postal Service on July 14, 2008 with sufficient postage as first class mail in an envelope  
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P.O. Box 1450  
Alexandria, VA 22313-1450

  
Jeffrey Sonnabend (36,282)

Date: July 14, 2008



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FEE**  
**Under 37 CFR 1.17(f), (g) & (h)**  
**TRANSMITTAL**  
(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents  
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	09/909,399
Filing Date	7/18/2001
First Named Inventor	Gu
Art Unit	3993
Examiner Name	Kaufman, Joseph A.
Attorney Docket Number	PLA1.010

Enclosed is a petition filed under 37 CFR 1.182 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 400 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.

**Payment of Fees** (small entity amounts are NOT available for the petition fees)

☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 502903:

☐ petition fee under 37 CFR 1.17(f), (g) or (h) ☒ any deficiency of fees and credit of any overpayments

Enclose a duplicative copy of this form for fee processing.

☐ Check in the amount of \$ \_\_\_\_\_ is enclosed.

☒ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

**Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462**

For petitions filed under:

- § 1.36(a) - for revocation of a power of attorney by fewer than all applicants
- § 1.53(e) - to accord a filing date.
- § 1.57(a) - to accord a filing date.
- § 1.182 - for decision on a question not specifically provided for.
- § 1.183 - to suspend the rules.
- § 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

**Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463**

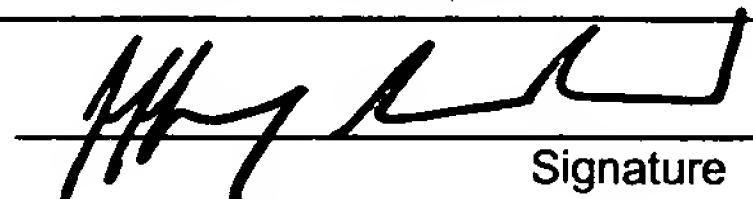
For petitions filed under:

- § 1.12 - for access to an assignment record.
- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) - for patent owner requests for extension of time in ex parte reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in inter partes reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

**Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464**

For petitions filed under:

- § 1.19(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.

  
\_\_\_\_\_  
Signature  
Jeffrey Sonnabend  
\_\_\_\_\_  
Typed or printed name

July 14, 2008  
\_\_\_\_\_  
Date  
36,282  
\_\_\_\_\_  
Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re U.S. Pat. No.: 6,722,674

Patentee: Hong-Jiu Gu et al.

Issued: April 20, 2004

Serial No.: 09/909,399

For: Safety Driving Equipment for Scooter

Art Unit: 3993

Examiner: J. Kaufman

Reexamination No. 95/000,355

**COMMUNICATION FROM REQUESTER**

Mail Stop Inter Partes Reexam  
Attention: Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I write concerning the multiple submissions made by patentee in the present case in response to the Office Action of May 2, 2008. Requester is deeply concerned about the manner in which patentee has elected to conduct itself in the present proceeding. This communication is not intended to be nor does it constitute Requester's written substantive response to the Patent Owner's response; this communication instead addresses important issues separate and apart from the substantive response. Upon resolution of the issues raised herein, Requester will submit its substantive response to the Patent Owner's response.

Patent Owner has submitted not one but two separate responses to the Office Action of May 2, 2008, one via the attorney of record, Raymond Y. Chan (also spelled "Chen"), and one by its litigation counsel, Venable LLP. Venable LLP is not of record and not entitled to submit in

papers in this proceeding. Patent Owner's course of action is particularly disturbing in light of the unsupportable, false, potentially biasing allegations made by Venable LLP in its papers.

For the following reasons, Requester believes that Patent Owner's actions violate 37 C.F.R. §§ 1.4 and 10.18. As a result of this violation, Requester respectfully requests that the instant proceeding be terminated pursuant to 37 C.F.R. § 10.18(c)(5). Upon termination, the status quo should be maintained, with claim 1 of the instant patent remaining finally rejected.

Alternatively, should the present proceeding not be terminated, Requester respectfully requests that Examiner disregard Venable LLP's submission of July 2, 2008 and expressly expunge same from the record. Should Venable LLP's submission of July 2, 2008 remain in the record, Requester hereby reserves the right to respond thereto.

**I. Patent Owner has Violated 37 C.F.R. §§ 1.4 and 10.18, and the Proceeding Should Be Terminated**

Requester filed the request for inter partes reexamination on March 6, 2008. The request was granted on May 2, 2008, and Examiner issued the currently pending office action at that time, rejecting the single claim at issue, claim 1.

On July 1, 2008, Requester was served with Patent Owners response to the May 2, 2008 Office Action. This response was filed by Patent Owners attorney of record, Raymond Y. Chan ("Chan's submission"). Then, one day later, Requester was served with a second response by Patent Owner to the Office Action, this time filed by Patent Owner's litigation counsel, Venable LLP ("Venable LLP's submission").

**A. Only the Attorney of Record May Respond to Office Actions - Venable LLP's Response is Improper**

The Patent Rules are clear: if an attorney of record exists, then the attorney of record, *and*

*only the attorney of record*, may communicate with the Patent Office on behalf of the Patent Owner:

All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the correspondence address. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

37 C.F.R. § 1.33(c), and see M.P.E.P. § 2622. The power of attorney in effect at issuance of a patent in inter partes reexamination remains in effect until such time that the patent owner revokes it and files a new power of attorney:

If the patent owner desires that a different attorney or agent receive correspondence, then a new power of attorney must be filed. Correspondence will continue to be sent to the attorney or agent of record in the patent file absent a revocation of the same by the patent owner. If the attorney or agent of record specifies a correspondence address to which correspondence is to be directed, such direction should be followed. However, since a change in the correspondence address does not withdraw a power of attorney, a change of the correspondence address by the patent owner does not prevent the correspondence from being directed to the attorney or agent of record in the patent file under 37 CFR 1.33(c).

M.P.E.P. § 2622.

Correspondence from unauthorized parties (e.g., from attorneys other than the attorney of record) will not be considered by the Patent Office:

If an unauthorized paper is filed by any party at any time during the inter partes reexamination proceeding it will not be considered and may be returned.

37 C.F.R. § 1.939(a).

Likewise, the Patent Office will not undertake correspondence with alternate attorneys – patent owner/applicant may only have one law firm representing him, not multiple firms:

Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

37 C.F.R. § 1.33(c).

Venable LLP, is not the attorney of record in the pending reexamination proceeding. The present attorney of record in the reexamination proceeding is Raymond Y. Chan (also spelled “Chen”) (see the Bibliographic Data Sheet). Patent Owner filed no revocation of Mr. Chan’s power of attorney nor filed a new power of attorney appointing Venable LLP. Thus, only communications from Mr. Chan are proper, and communications from other parties, including Venable LLP, are improper and cannot be made part of the record.<sup>1</sup>

**B. Patent Owner Has Violated 37 C.F.R. §§ 1.4 and 10.18 and the Present Proceeding Should be Terminated**

More troubling than Patent Owner’s and Venable LLP’s disregard for the Patent Rules is the fact that they ignored the rules to introduce baseless allegations of wrongdoing by Requester. Patent Owner and Venable LLP have acted in violation of 37 C.F.R. § 10.18(b)(2)(i) and (iii).

**1. Patent Owner’s Submission by Venable LLP Violates 37 C.F.R. § 10.18(b)(2)(iii)**

First, 37 C.F.R. § 10.18(b)(2)(iii) states, that by submitting a document to the Patent Office, a practitioner such as Venable LLP is certifying that

[t]he allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have

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<sup>1</sup> Requester notes that the transaction history of the present proceeding shows two entries for “Response after non-final action - owner - timely”, namely, one from Mr. Chan and one from Venable LLP.



evidentiary support after a reasonable opportunity for further investigation or discovery.

Despite this express requirement to refrain from filing papers containing baseless allegations, Patent Owner, through its trial counsel Venable LLP, submitted papers containing repeated alleges, both expressly and by direct implication, that Requester and/or its legal counsel have perpetrated fraud. These allegations include, among others, allegations that the Song reference (one of two references forming the basis for the reexamination) and/or the translation thereof submitted by Requester to the Patent Office were “fabricated” and “fraudulent”. These allegations are repeated, for example, on pages 3, 5 and 10 of Venable LLP's submission.

Patent Owner's allegations of fraud contained in Venable LLP's submission are utterly baseless. Tellingly, the July 2 submission is completely devoid of any factual support for the allegations whatsoever. Venable LLP's submission instead, the papers simply repeat *ad nauseum*, Venable LLP's self serving conclusion that the Song reference and/or translation thereof submitted by Requester is “fabricated” and “fraudulent”. These bald assertions, without so much as a wisp of support, not only step over the line of conduct drawn by 37 C.F.R. § 10.18(b)(2)(iii), they charge head-first past it.

The Venable LLP submission weaves an incredible tale of intrigue, portraying a nefarious plot between Requester and the Chinese manufacturer of Requester's product. See Venable LLP's submission at 4-6. Each and every allegation of wrongdoing underlying the conclusion of fraud, however, is made “upon information and belief” (except, perhaps, for the allegation that the Chinese manufacturer and Requester are in some vague state of “privity”). Venable LLP has made each and every critical factual allegation “upon information and belief” because it has no evidence whatsoever that it's assertions are accurate. This minor detail – a complete lack of

factual support for its reckless conclusions – does nothing to stop Venable LLP from making the allegations.

What is more, an exploration of the substance of Venable LLP's assertions of fraud – to the extent they possess any substance – shows them to be virtually nonsensical. Specifically, Venable LLP alleges that the “fabricated” and “fraudulent” submission included disclosure of

inter alia a multi function or “seven-using” toy, and these multiple alleged functions are not supported by the patent drawings or translated specification. For example, the fabricated translation of the reference discloses that the toy can be assembled and disassembled in different manners to result in a pull cart, a children's bed, a wooden horse, a tricycle, and a toilet seat. See p. 3 of the Song specification submitted by PlaSmart [Requester]. Yet there are no drawings that in any way support these features.

Venable LLP's submission at 6. Venable LLP's position is apparently that the added disclosure materials (i.e., the disclosure materials added to the Song reference) has nothing to do whatsoever with the present application. Requester agrees entirely with this position.

What Venable LLP fails to explain is this: what motivation would Requester have to add irrelevant disclosure to a reference that otherwise renders the present application invalid? The answer is: none. There is simply nothing to be gained by adding irrelevant disclosure to an otherwise highly relevant reference. What is more, Requester's arguments in support of reexamination, and Examiner's rejection in his May 2, 2008 Office Action, do not cite the irrelevant, apparently erroneous, portions of the Song reference as submitted (e.g, the disclosure of a children's bed and toilet); both Requester and Examiner referred only to those portions of the Song reference that are relevant, none of which Venable LLP alleges are improperly included. Not only are Venable LLP's allegations of fraud supported by a shred of evidence, they make no sense as well.

**2. Patent Owner's Submission by Venable LLP Violates 37 C.F.R. § 10.18(b)(2)(i)**

37 C.F.R. § 10.18(b)(2)(i) states, that by submitting a document to the Patent Office, a practitioner such as Venable LLP is certifying that

[t]he paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office.

As with the proscriptions of 37 C.F.R. § 10.18(b)(2)(iii), it appears that Patent Owner, through its litigation counsel Venable LLP and its attorney of record in the present case, Mr. Chan, is seeking to do exactly what cited rule prohibits – harass Requester, requiring it to undertake unnecessary work, thereby increasing its cost.

Both Mr. Chan and Venable LLP submitted responses to the Office Action of May 2, 2008. Each response includes extensive (albeit meritless) substantive arguments against the rejection of claim 1.<sup>2</sup> In addition, Mr. Chan's response adds 14 new claims to the application. The two responses total more than 30 pages. Addressing each of these responses is a significant task; responding to both is a formidable undertaking.

Electing not to respond to one or the other of Patent Owner's two submissions is not a viable option for Requester, however, as failing to respond within the time prescribed by the Rules acts as a waiver of the right to respond:

a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the

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<sup>2</sup> Each response apparently includes the very same translation of the Song reference. It follows from this that both Mr. Chan and Venable LLP received the reference from the same source, likely from the Patent Owner himself. In any event, it is nearly impossible for Patent Owner to argue that the two submissions were made inadvertently considering both Mr. Chan and Venable LLP used the same translation.

Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended.

37 C.F.R. § 1.947. Thus, by not responding to both of Patent Owner's submissions – both Mr. Chan's submission and Venable LLP's submission – Requester runs the real risk of waiving its right to respond.<sup>3</sup> Surely, both Mr. Chan and the attorneys of Venable LLP are aware of the mandates of 37 C.F.R. § 1.947, and so the impact of their violation of 37 C.F.R. § 1.33(c) must have been known to each.

In short, Venable LLP is clearly not authorized to respond under 37 C.F.R. §§ 1.33(c) and 1.939(a), only Mr. Chan is, yet Patent Owner decided to have both Mr. Chan and Venable LLP submit responses, forcing Requester into the untenable, costly position of having to answer two different Patent Owner responses or fear waiving its rights to respond. This tactic is surely designed to harass Requester and increases its costs.

### **3. Patent Owner's Submissions Warrant Termination of the Present Proceeding**

37 C.F.R. § 10.18(c) provides for a variety of sanctions for violations of 37 C.F.R. § 10.18(b)(2):

Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of --

(1) Holding certain facts to have been established;

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<sup>3</sup> In section II, Requester requests that, should the Patent Office not terminate the instant proceeding due to Patent Owner's violation of 37 C.F.R. § 10.18, Examiner disregard Venable LLP's submission, expunging it from the record. Thereafter, Requester would be able to respond properly and substantively to Patent Owner's single response to the Office Action of May 2, 2008.

- (2) Returning papers;
- (3) Precluding a party from filing a paper, or presenting or contesting an issue;
- (4) Imposing a monetary sanction;
- (5) Requiring a terminal disclaimer for the period of the delay; or
- (6) Terminating the proceedings in the Patent and Trademark Office.

As the foregoing discussion illustrates, Patent Owner has violated 37 C.F.R. § 10.18(b)(2)(i) and (iii). Requester believes the reasons for these violations are readily apparent: (i) to introduce unsupportable allegations to “smear” PlaSmart and its counsel in an attempt to bias the proceedings in Patent Owner’s favor; and (ii) to introduce dual submissions to harass Requester by increasing its workload substantially, thereby increasing its expenses.

Under 37 C.F.R. § 10.18(c)(6), the Patent Office may impose the sanction of “terminating the proceeding[] in the Patent and Trademark Office.” Requester respectfully suggests that this sanction would be appropriate, and requests entry of it.

## **II. If the Proceeding is not Terminated, the Venable LLP Submission Should be Disregarded and Expunged from the Record**

As discussed in detail above, 37 C.F.R. § 1.33(c) dictates that only the attorney of record, when one exists, is permitted to correspond with the Patent Office on behalf of a patent owner. As further discussed in detail above, 37 C.F.R. § 1.939(a) states that “unauthorized papers” filed at any time during an inter partes reexamination “will not be considered” by the Patent Office.

Again, as discussed in detail above, Venable LLP is not the attorney of record for Patent Owner, Mr. Chan is, and so Venable LLP is not permitted to submit correspondence on behalf of Patent Owner. The Venable LLP submission is therefore an “unauthorized paper”, and must be


refused consideration pursuant to 37 C.F.R. § 1.939(a).

To be clear, Requester believes that Patent Owner's submission of two responses – one from Mr. Chan and one from Venable LLP – was intentional and is sanctionable for the reasons detailed in section I, despite the fact that Venable LLP's submission must be disregarded pursuant to 37 C.F.R. § 1.939(a). The harm caused by the dual submission, both in the time and expense required to prepare the present papers, as well as the prejudicial nature of the unsupported allegations made in the Venable LLP submission, cannot be undone by merely “refusing consideration” of the Venable LLP submission. Requester asks for the relief of Section II solely as a precaution, to ensure that, should the proceeding not be terminated, the Patent Office directs Requester to respond to the proper one of Patent Owner's two submissions.

### **III. Conclusion**

Patent Owner has, at best, recklessly, and at worst, intentionally, disregarded 37 C.F.R. §§ 1.4 and 10.18 by submitting unsupported allegations of fraud against requester and/or its attorney. Patent Owner's actions also violate 37 C.F.R. § 10.18(b)(2)(i), filing “double” papers which harass Requester and improperly increase Requesters expenses. The instant action should therefore be terminated in its present state pursuant to 37 C.F.R. § 10.18(c)(6).

At a minimum, Examiner should disregard the submission by Venable LLP, expunging it from the record, and instructing Requester to respond only to the submission by Mr. Chan.



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Attorney for Requester  
Jeffrey Sonnabend (36,282)  
SonnabendLaw  
600 Prospect Avenue  
Brooklyn, NY 11215  
JSonnabend@SonnabendLaw.com

### **CERTIFICATE OF SERVICE**

I hereby certify on this day, July 14, 2008, that a true and correct copy of the foregoing

Communication from Requester was mailed by Express Mail, postage paid, to:



Raymond Y. Chan  
108 N. Ynez Avenue  
Suite 128  
Monterey Park, CA 91754

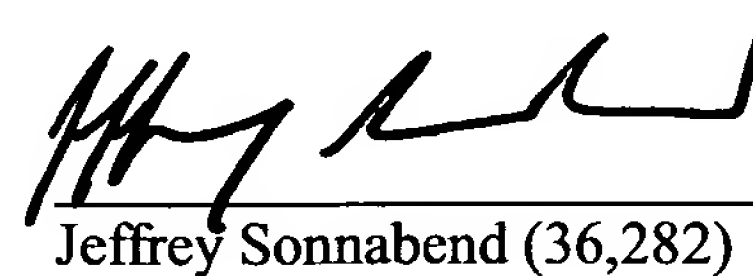
  
\_\_\_\_\_  
Jeffrey Sonnabend (36,282)

Date: July 14, 2008

### **CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8**

I hereby certify that the foregoing correspondence is being deposited with the United States Postal Service on July 14, 2008 with sufficient postage as first class mail in an envelope addressed to:

Mail Stop Inter Partes Reexam  
Attention: Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

  
\_\_\_\_\_  
Jeffrey Sonnabend (36,282)

Date: July 14, 2008